

**BRIEF FOR APPELLEE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

United States Court of Appeals
for the Federal Circuit

No. 2008-1151
(Serial No. 09/326,405)

IN RE DAVE B. LUNDAHL

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

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Representative Claim

11. An operable window system with a removable screen comprising:
- a fixed frame;
 - a moving sash connected to said fixed frame and operable to substantially swing about an axis with respect to said fixed frame from an open position to a closed position; and
 - a removable screen without a substantially rigid peripheral frame removably connected to said fixed frame with hook and loop fasteners, said removable screen mounted between said fixed frame and said moving sash.

A63.

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STATUTES

35 U.S.C. § 103	2, 26
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STATEMENT OF RELATED CASES

- (a) The Director is not aware of any other appeal involving the underlying decision in this case that was previously before this or any other appellate court.
- (b) The Director is also not aware of any pending case in this or any other court that will directly affect, or be directly affected by, this Court's decision in this appeal.

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Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

I. STATEMENT OF THE ISSUE

Lundahl claims a window screen attached to a casement window by hook-and-loop fasteners, *e.g.*, “Velcro” brand fasteners. The Board affirmed the examiner’s *prima facie* case of obviousness and found Lundahl’s evidence of commercial success insufficient to overcome it. On appeal, Lundahl does not dispute the examiner’s *prima facie* obviousness case, but argues only that the Board failed to give his rebuttal evidence of commercial success sufficient weight. The sole issue on appeal, therefore, is whether the Board properly found Lundahl’s evidence of commercial success insufficient to overcome the examiner’s undisputed *prima facie* case of obviousness.

II. STATEMENT OF THE CASE

This case concerns Lundahl's patent application, serial no. 09/326,405 ("the '405 application") entitled "Improved Window Screen System." A241-257. The examiner rejected claims 11-13, 15-18, 20-23, 25-28 and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,713,896 to Kehne ("Kehne," A258-264) in view of U.S. Patent No. 3,753,458 to Lazarek ("Lazarek," A265-268). A84-85. The examiner rejected claims 14, 19, 24, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Kehne in view of Lazarek and further in view of U.S. Patent No. 5,365,707 to Jones *et al.* ("Jones," A284-291). A85. Lundahl appealed the Examiner's final rejection to the Board, which affirmed the examiner. A13-20. The Board subsequently denied Lundahl's rehearing request. A1-3. This appeal followed.

III. STATEMENT OF THE FACTS

A. The Claimed Invention

The appealed claims are generally drawn to a casement window comprising a screen mesh secured to the window frame by hook-and-loop fasteners (*e.g.*, Velcro®). Claim 11 is illustrative of Lundahl's invention:¹

¹ Lundahl's opening brief does not argue a specific claim.

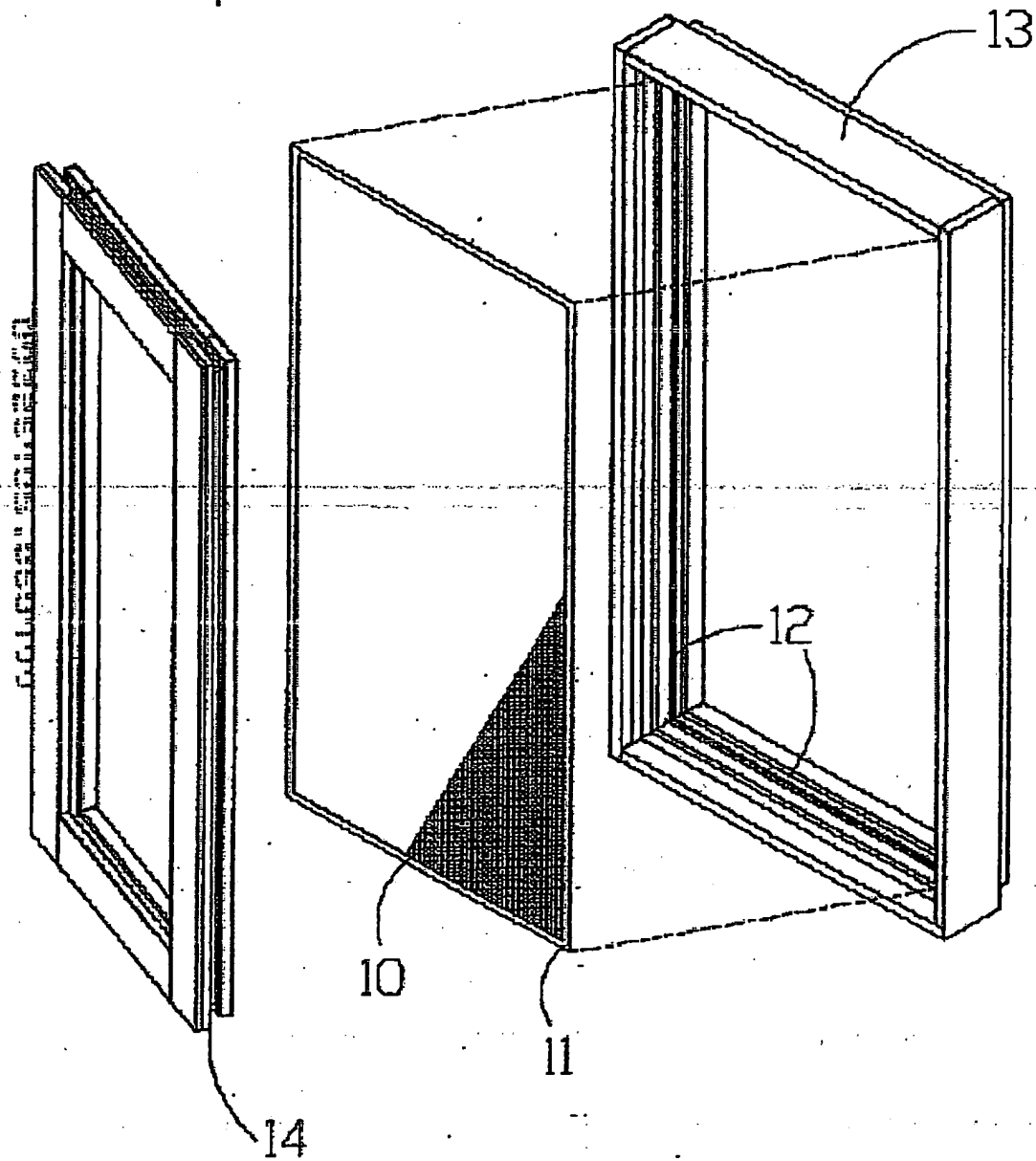


Fig. 1

Lundahl, Fig. 1

An operable window system with a removable screen comprising:

[a] a *fixed frame*;

[b] a *moving sash* connected to said fixed frame and operable to substantially swing about an axis with respect to said fixed frame from an open position to a closed position; and

[c] a *removable screen without a substantially rigid peripheral frame* removably connected to said fixed frame with *hook and loop fasteners*,

[d] said removable screen mounted between said fixed frame and said moving sash.

A63 (reformatted and labeled for clarity; emphasis of key elements added).

Figure 1 (shown on facing page) depicts an embodiment of the invention.

A continuous strip of fastener material 11 (*e.g.*, the loop portion of hook-and-loop fastener material) is attached to the edges of screen mesh 10. A247, A253.

A continuous strip of fastener material 12 that mates with fastener material 11 (*e.g.*, the hook portion of hook-and-loop fastener material) is attached to window frame 13. *Id.* Window sash 14 is adapted to be attached to the window frame 13 so that the sash swings in or out along an axis of the window frame. A246, A247, A253. When window sash 14 is open, the edges of the screen mesh can be pushed against a corresponding edge of the window frame to affix the mesh to the window frame. A247, A253.

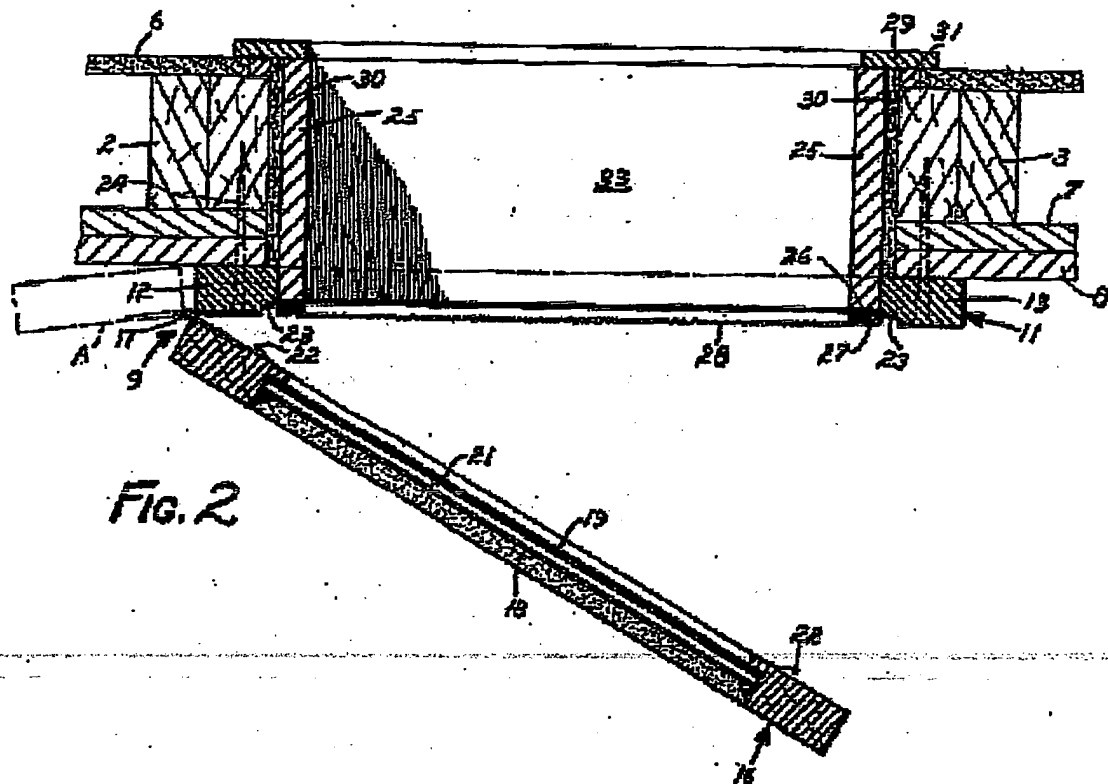


Fig. 2

Kehne, Fig. 2

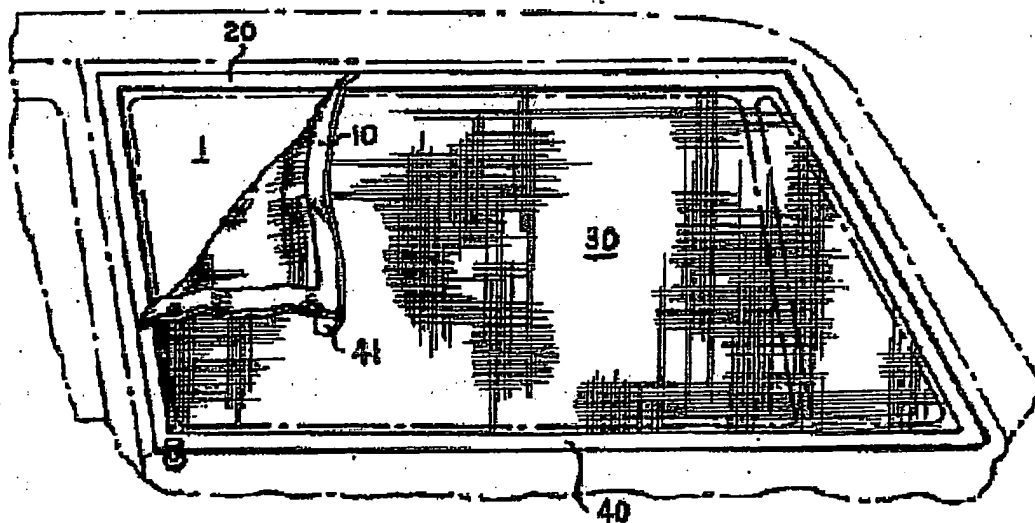


FIGURE 1

Lazarek, Fig. 1

B. The Prior Art

1. Kehne

Kehne teaches an operable window system comprising a *fixed frame*; a *moving sash* connected to the fixed frame such that it swings about an axis from an open position to a closed position; and a *screen* mounted between the fixed frame and the moveable sash. A258 (figs. 1, 2); A263, (col. 3, lines 34-40).

Figure 2 of Kehne (shown on facing page) depicts a casement window with a fixed frame **11** and a moving sash frame **16**. The sash frame **16** is hinged to the fixed frame **11** on one side so that it moves about an axis of the fixed frame **11**. A258; A262-63 (col. 2, lines 42-44; col. 2, line 71 - col. 3, line 4). A screen **28** having a frame **27** is situated between the fixed frame **11** and the moving sash frame **16**. A258; A263 (col. 3, lines 34-40).

2. Lazarek

Lazarek discloses a *removable screen without a substantially rigid peripheral frame* removably connected to the fixed frame of a car window with *hook-and-loop fasteners*. A266 (figs. 1, 2); A267 (col. 1, lines 43-63; col. 2, lines 59-66).

Figure 1 of Lazarek (shown on facing page), depicts screen **30**, which does not have a rigid peripheral frame, attached to a car window frame by Velcro

brand hook-and-loop material. A266; A267 (col. 1, lines 43-63). The screen thus “may be demountably installed without the use of tools, without defacing the window frame [and] may be stored in a minimum of space when not in use.” A267 (col. 2, lines 20-25).

3. Jones

Jones depicts a non-rectangular louvered vent body with a screen attached thereto. A287 (fig. 3); A289 (col. 4, lines 26-28).

C. Lundahl’s Evidence of Commercial Success

Lundahl presented two declarations as evidence of the purported commercial success of his invention: (1) the declaration of Randy Helzer, an employee of Lundahl’s company “Point Five Windows,” and (2) the declaration of Michael Thompson, an architect who had worked with Mr. Helzer on a residence project.

1. The Helzer Declaration

Mr. Helzer declared that he is an employee of Point Five Windows, a company part owned by Lundahl. A70-71. He alleged that Point Five Windows sells the “Frameless Velcro Screen System,” a window that meets the limitations of the asserted claims. A70. Mr. Helzer described a number of advantages that flowed from using a hook-and-loop-fastener frame instead of the conventional

rigid metal frame in the Frameless Velcro Screen System window: (1) for frame spans greater than five feet, the need for a support member to prevent sagging and bowing, and the susceptibility to damage, are avoided; (2) for frames that are “curved or oddly shaped,” the Frameless Velcro Screen System screens are easier to manufacture; (3) for frames used in a salt-spray environment, the corrosion of metal-framed screens is avoided; and (4) the screen is less visually intrusive for casement type windows. A71-72.

Mr. Helzer further alleged that “Point Five Windows has sold over \$6,300,000 in 15 major orders of window systems that include the Frameless Velcro Screen System.” A71. One of these orders, in the amount of \$720,000, for “windows and doors for use in a salt water environment in the Bahamas,” was “awarded in large part specifically because the Frameless Velcro Screen System eliminated the conventional aluminum screen frame that would have been susceptible to deterioration in the harsh salt air environment of the Bahamas.” *Id.* Another \$580,000 order for Frameless Velcro Screen System windows allegedly was awarded because in such windows “the screen was mounted between the fixed frame and moving sash for a casement window.” A72.

2. The Thompson Declaration

Thompson alleged that he is an architect who worked with Mr. Helzer on the \$580,000 contract mentioned in Mr. Helzer's declaration. Mr. Thompson alleged that Point Five Windows used the Frameless Velcro Screen System product on "numerous casement windows" on the \$580,000 contract; that the award to Point Five Windows was due "in part" to the Frameless Velcro Screen System; and that the architectural firm where he worked supported the \$580,000 contract award to Point Five Windows based "in part" on the fact that the Frameless Velcro Screen System offered "aesthetic and functional differences over any other known solution, which included conventional screen frames."

A79.

D. The Board Decisions

The Board affirmed the examiner's *prima facie* case of obviousness of the appealed claims. The Board agreed with the examiner that it would have been obvious for an ordinary window designer to employ a hook-and-loop-fastened screen as in Lazarek with a window system like Kehne's to provide the advantage of enabling the screen to be readily mounted and dismounted. A15. The Board further concluded that Lundahl's evidence of commercial success, the

Helzer and Thompson Declarations, did not outweigh the strong evidence of obviousness presented by the examiner. A19.

With respect to the assertion in the Helzer Declaration that Point Five Windows “sold over \$6,300,000 in 15 major orders of window systems that include the Frameless Velcro Screen System,” the Board explained there was no indication of what proportion of that sum represents the sale of window systems that practice the claimed invention. A17-18. The Board also noted that Mr. Helzer failed to state what portion of the \$720,000 contract for “unspecified” windows and doors” was attributable to the Frameless Velcro Screen System. A18.

With regard to the \$580,000 contract, which Mr. Helzer had testified was specifically awarded because the screen was mounted between the fixed frame and moving sash for a casement window, the Board noted that the window system of the Kehne reference is also configured with the screen mounted between the fixed frame and the moveable sash. A18. Finally, the Board found that although Mr. Helzer stated that conventional screen frames with spans greater than five feet require supplemental members, the claimed invention does not recite any particular size for the screen. A18.

The Board found the Thompson Declaration to be similarly flawed. For example, the Board noted that the \$580,000 contract award was “due in part” to the window system of the present invention. A18. As a result, the Board concluded that neither the Helzer Declaration nor the Thompson Declaration demonstrated the requisite nexus between the asserted commercial success and window systems within the scope of the appealed claims. A18-19. The Board reiterated this conclusion in its rehearing decision. A1-3.

IV. SUMMARY OF THE ARGUMENT

Lundahl claims a window comprising a screen attached between the fixed and moveable frames of the window by hook-and-loop fasteners. Lundahl does not dispute that the appealed claims would have been *prima facie* obvious in light of the prior art cited by the examiner, but limits his arguments solely to whether his secondary evidence of commercial success renders his claims patentable. Lundahl’s evidence purporting to show commercial success of the appealed claims is insufficient to overcome the undisputed *prima facie* case of obviousness of the claims. Lundahl fails to show a nexus between the full amount of commercial sales alleged and the appealed claims. Further, contrary to Lundahl’s assertions, the burden did not shift to the U.S. Patent and Trademark Office (“USPTO”) to show that commercial success is due to other factors, but

remained on Lundahl to show that the alleged commercial success is due to the sale of claimed products.

V. ARGUMENT

A. Standard of Review

The ultimate issue of obviousness is a legal question based on underlying factual findings. *See In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

What the prior art teaches, and the meaning of any objective evidence of nonobviousness, are issues of fact. *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995).

On appeal, the Board's factual findings are reviewed for substantial evidence, and the Board's legal conclusions are reviewed *de novo*. *Gartside*, 203 F.3d at 1315. Substantial evidence "means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion."

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229 (1938). "[T]he possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence." *Consolo v. Fed. Mar. Comm'n*, 383 U.S. 607, 620 (1966) (citation omitted).

B. The Board Correctly Held That the Examiner Had Made out a Prima Facie Case of Obviousness for Claim 1, Which Lundahl Does Not Dispute

Lundahl does not dispute in his opening brief the examiner's *prima facie* case of obviousness. Thus, Lundahl may not dispute it on appeal. *Novosteel SA v. United States*, 284 F.3d 1261, 1274 (Fed. Cir. 2002). Regardless, the Board correctly affirmed the examiner's *prima facie* case that the appealed claims would have been obvious.

Lundahl's claimed invention is a window comprising: (1) a fixed frame; (2) a moving sash connected to the fixed frame such that it swings about an axis of the fixed frame; (3) a screen without a rigid peripheral frame removably connected to the fixed frame with hook-and-loop fasteners; and (4) the screen mounted between the fixed frame and the moving sash. A63.

The primary reference, Kehne, discloses: (1) a fixed frame; (2) a moving sash connected to the fixed frame such that it swings about an axis of the fixed frame; (3) a screen that is (4) mounted between the fixed frame and the moving sash. A258 (figs 1, 2); A262-63 (col. 2, lines 42-44; col. 2, line 71 -col. 3, line 4; col. 3, lines 34-40).

The only difference between Kehne and the claimed invention is that the screen of Kehne has a rigid frame and is not attached to the fixed frame by hook-

and-loop fasteners. Lazarek, however, discloses a screen without a rigid frame removably connected to a car window with hook-and-loop fasteners. A266 (figs. 1, 2); A267 (col. 1, lines 43-63; col. 2, lines 59-66). As both the examiner and Board found, a person of ordinary skill in the art of designing windows would have combined a hook-and-loop-fastened screen as in Lazarek with a casement window like Kehne in order for the screen to be more readily removed. *See* A15 (Bd. Dec. at 3) (“we concur with the examiner that it would have been obvious for one of ordinary skill in the art to employ the hook and loop fasteners of Lazarek in the window system of Kehne to provide the described advantage of enabling the screen to be readily mounted and dismounted”).

Moreover, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Agrizap, Inc. v. Woodstream Corp.*, ___ F.3d ___, 2008 WL 819757, at *4 (Fed. Cir. Mar. 28, 2008) (quoting *KSR Int’l Co. v. Teleflex, Inc.*, ___ U.S. ___, 127 S. Ct. 1727, 1739 (2007)). As in *Agrizap*, this is a “textbook case” of such an occurrence. The claimed invention simply substitutes well-known hook-and-loop fasteners for the prior art rigid metal frame to attach a screen to a window, in precisely the same way that Lazarek uses hook-and-loop fasteners to attach a screen to a car window. Both the screen and hook-and-loop fasteners, as

well as the use of hook-and-loop fasteners to attach a screen to a window, were already well-known in the art long before Lundahl's invention.

C. The Board Correctly Held That Lundahl's Evidence of Commercial Success Was Insufficient to Overcome the Prima Facie Case of Obviousness

When the USPTO demonstrates a *prima facie* case of obviousness, as was done here, the burden shifts to the applicant to show non-obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Even "substantial evidence of commercial success, praise, and long-felt need" may be insufficient to overcome a strong showing of obviousness. *Leapfrog Enter. Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). Lundahl's evidence of commercial success is far from substantial, as discussed below, and is insufficient to overcome the examiner's *prima facie* case of obviousness.

1. The Helzer and Thompson Declarations Do Not Show That Lundahl's Invention Is Commercially Successful Because There is an Insufficient Showing of Nexus Between The Alleged Commercial Success and the Claims

"In the *ex parte* process of examining a patent application . . . the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success." *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996). The applicant must therefore present "hard

evidence” that the commercial success the product at issue is a “direct result of the unique characteristics of the claimed invention – as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.” *Huang*, 100 F.3d at 140 (Fed. Cir. 1996); *see also In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (giving little weight to evidence of extensive licensing, widespread acceptance, and failure of others due to failure to show nexus); *In re Paulson*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) (finding evidence of copying, commercial success, and professional recognition deficient for lack of nexus in a reexamination).

Lundahl argues that the Frameless Velcro Screen System window, which embodies the claimed invention, has enjoyed \$6,300,000 in commercial success since 1998; he further argues that such commercial success is sufficient to render the appealed claims non-obvious. Br . at 4-6, 14. But as the Board recognized, Lundahl’s declarations fail to establish a nexus between the commercial sales and the merits of the claimed invention. This is because Lundahl’s evidence of commercial success suffers from two key infirmities: (1) It does not show that the full \$6,300,000 of sales were of Frameless Velcro Screen System windows; and (2) it suggests that the sale of the Frameless Velcro Screen System windows could be attributed to factors other than the merits of the claimed invention.

a. The Helzer Declaration

According to Mr. Helzer, since 1998 “Point Five Windows has sold over \$6,300,000 in 15 major *orders* of window systems that *include* the Frameless Velcro Screen System.”² A71, ¶ 15. While not entirely clear, Lundahl’s assertion that the 15 major *orders* “include” the Frameless Velcro Screen System windows leaves open the very real possibility that the orders also include windows that are not covered by the appealed claims.³ As the Board found, Mr. Helzer did not specify what proportion of the \$6,300,000 figure represents the sale of Frameless Velcro Screen System windows. A18.

Here, Lundahl urges this Court to infer that *all* of the \$6,300,000 worth of commercial sales are of Frameless Velcro Screen System windows:

The plain language of paragraph 15 states that the sale of \$6,300,000 of window systems includes the Frameless Velcro Screen System. The plain meaning of this language is that all of the window systems include the Frameless Velcro Screen System.

² The Director accepts for purposes of this appeal Mr. Helzer’s assertion that the Frameless Velcro Screen System windows practice at least one of the appealed claims.

³ As discussed below, it appears that at least one of these orders for “window systems” also includes *doors*.

Br. at 5-6 (underlining in original). Lundahl thus asks this Court to interpret the disputed statement as stating that the *window systems* include the Frameless Velcro Screen System windows. This is not a reasonable interpretation of Mr. Helzer's testimony. Mr. Helzer defines the Frameless Velcro Screen System as an entire window casement window system, not just a screen. A70, ¶ 6 (declaring that Frameless Velcro Screen System includes a casement window, etc.). While it might make sense to say that a window system "includes" a particular type of screen, it makes less sense to say that a window system "includes" a window system.

More importantly, if Point Five Windows had actually sold \$6,300,000 worth of Frameless Velcro Screen System windows, it could have stated so clearly, rather than stating ambiguously that it had sold 15 orders that merely "include" Frameless Velcro Screen System windows. Because Lundahl is the cause of any doubt as to whether or not the entire \$6,300,000 in commercial sales is attributable to the Frameless Velcro Screen System windows, it should not be given the benefit of that doubt.

Finally, even if both Lundahl's and the Board's interpretations of Mr. Helzer's statement in paragraph 15 are reasonable, the Board's interpretation must be affirmed because it is supported by substantial evidence. *In re Jolley*,

308 F.3d 1317, 1320 (Fed. Cir. 2002) (“If the evidence in record will support several reasonable but contradictory conclusions, we will not find the Board’s decision unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative.”). Accordingly, evidence of record supports the Board’s finding that only a portion of the \$6,300,000 in sales were of the Frameless Velcro Screen System.

Mr. Helzer also discusses a particular order for \$720,000 “for windows and doors for use in a salt water environment in the Bahamas.” A71, ¶¶ 18-19. As the Board found, it cannot be assumed that this sales figure is entirely attributable to the sale of Frameless Velcro Screen System windows. *See* A18 (noting that the \$720,000 contract was for “unspecified windows and doors”). Here, Lundahl argues that the Board erred in this regard, since in the next paragraph of Mr. Helzer’s declaration he specifically mentions the Frameless Velcro Screen System. Br. at 6.

Lundahl is wrong on the facts. It is clear from the record that not all of the \$720,000 contract was for Frameless Velcro Screen System windows, because Mr. Helzer admits that the contract also included *doors*.⁴ None of the

⁴ Presumably this \$720,000 contract is one of the “15 major orders” comprising the \$6,300,000 in sales mentioned in paragraph 15 of Mr. Helzer’s

claims on appeal cover doors. Moreover, Mr. Helzer stated that the contract was awarded “in large part” because of the elimination of the conventional aluminum frame. Mr. Helzer’s use of the term “in large part” implies that other unclaimed factors may have played a role, thus further discounting the significance of the \$720,000 figure.

Mr. Helzer next states that Point Five Windows was awarded a contract for \$580,000 for casement type windows due “in part” to the aesthetic value of the Frameless Velcro Screen System. Again, Mr. Helzer’s hedging language reflects that it is unclear how significant the aesthetic value of the Frameless Velcro Screen System windows was to the contract award, in comparison to factors other than those claimed.

b. The Thompson Declaration

Lundahl also takes issue with the Board’s analysis of the Thompson declaration. Mr. Thompson declared that his design firm “supported a contract award to Point Five Windows in excess of \$580,000 for numerous windows for a

declaration. Since not all of the \$720,000 can be attributed to Frameless Velcro Screen System *windows*, it is clear, contrary to Lundahl’s assertions, that not all of the \$6,300,000 total sales figure can be attributed to Frameless Velcro Screen System windows. Further, it raises the possibility that some of the other 14 orders may also include doors and not just windows.

residence project; that Point Five Windows used the Frameless Velcro Screen System on numerous casement windows on the above mentioned residence project; and that the award to Point Five Windows was due in part to the Frameless Velcro Screen System.” A79.

But as with the Helzer declaration, it is simply unclear what percentage of the \$580,000 figure is attributable to the sale of Frameless Velcro Screen System windows as opposed to other types of windows. For example, Mr. Thompson declared that Point Five Windows used the Frameless Velcro Screen System windows on “numerous” casement windows, rather than all of the windows.

A79, ¶ 4. Mr. Thompson also declared that the award to Point Five Windows was due “in part” to the Frameless Velcro Screen System windows, suggesting that other unclaimed factors played a part in the selection of Point Five Windows as the contractor. Based on this evidence, the Board justifiably found a lack of nexus between the entire \$6,300,000 in sales and the appealed claims, and, accordingly, gave the Thompson declaration little weight.

2. Lundahl Is Not Entitled to a Presumption of Nexus

Lundahl relies on *Damaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387 (Fed. Cir. 1988) and other cases to argue that once evidence of commercial success has been presented, Lundahl is entitled to a presumption that

a nexus exists between the commercial success and his claimed invention. Br. at 13-14. Lundahl argues that, under these cases, the burden shifts to the USPTO to show lack of Nexus, *i.e.*, that other factors such as advertising, rather than the claimed inventive features, were the source of the commercial success.

Lundahl's brief, however, fails to address *Huang*, which expressly rejects *Damaco*'s burden shifting approach in prosecution before the USPTO. *Damaco* discusses an "evidentiary routine" with respect to the consideration of evidence of commercial success in an *inter partes* civil action, placing the burden on the challenger to rebut the nexus presumption by showing that the commercial success was due to extraneous factors, such as advertising. *Damaco*, 851 F.2d at 1393. *Huang* specifically rejects that burden shifting routine for USPTO prosecution proceedings. Indeed, *Huang* cites with approval *Ex Parte Remark*, 15 USPQ.2d 1498, 1503 (Bd. Pat. App. & Int. 1990), recognizing that "[t]he evidentiary routine of shifting burdens in civil proceeding [is] inappropriate in *ex parte* prosecution proceedings because [the] examiner has no available means of adducing evidence." *Huang*, 100 F.3d at 139-40. Consequently, the burden remains on Lundahl to provide "hard evidence" that any commercial success was not attributable to other factors such as lower costs, unclaimed features, etc. *Id.*; *see also Paulson*, 30 F.3d at 1482 ("It has not been shown that such evidence is

relevant to a computer within the scope of the claims, *i.e.*, that it is attributable to the inventions of these claims, rather than to extraneous factors such as advertising and marketing or to the features possessed by the computers of claims 1 and 18.”). Accordingly, given that the present appeal arises from USPTO prosecution rather than a district court *inter partes* action, the case law that Lundahl relies on, such as *Damaco*, is unavailing.

3. Lundahl’s Evidence of Commercial Success Is Not Commensurate in Scope with the Appealed Claims

Lundahl argues that “advantages of the invention, that relate to the reasons why the claimed invention has sold, do not have to be recited in the claims.” Br. at 8. He further asserts that the Frameless Velcro Screen System is commercially successful because of several specific advantages resulting from the elimination of the conventional rigid metal frame from the screen: (1) for frame spans greater than five feet, the need for a support member to prevent sagging and bowing of the screen, and the susceptibility to damage, are avoided; (2) the ease of manufacture of screens that are curved or oddly shaped; (3) the corrosion resistance of screens exposed to salt spray; and (4) the fact that screens framed with hook-and-loop fasteners are less visually intrusive than conventionally framed screens in casement windows. Br. at 10-13, A71-72.

Lundahl's argument is unavailing. First, while the commercial success of a product may not need to be due to a limitation expressly stated in an appealed claim, it must be due to the "nature of the claimed invention," *i.e.*, "the technical quality of the patented subject matter." *Cable Elec. Prod., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985). Importantly, objective evidence of non-obviousness, such as of commercial success, must be "commensurate in scope with the claims which the evidence is offered to support." *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003) (quoting *In re Tiffin*, 448 F.2d 791, 792 (C.C.P.A. 1971)). That is not the case here. Indeed, there is somewhat of a mismatch between the evidence presented by Lundahl and the scope of the appealed claims. For example, with respect to the first advantage enumerated above, none of the appealed claims are limited to windows having spans greater than five feet; nor is there any indication in Mr. Helzer's declaration as to how many of the Frameless Velcro Screen System windows sold, if any, had spans greater than five feet. While Mr. Helzer expressed the opinion that Frameless Velcro Screen System windows provide a "competitive advantage" for Point Five Windows, and that Point Five Windows has "successfully sold" Frameless Velcro Screen System windows with spans larger than five feet, this testimony amounts to little more than a conclusory assertion

and opinion that is deserving of little weight. *See Huang*, 100 F.3d at 140 (conclusory assertions and opinions insufficient to satisfy nexus requirement).

With respect to the second enumerated advantage, while four of the 25 appealed claims are limited to “non-rectangular” windows, none of the appealed claims are specifically limited to “curved or oddly shaped” windows; further, there is no indication in Mr. Helzer’s declaration as to how many of the Frameless Velcro Screen System windows sold, if any, were curved or oddly shaped. Again, Mr. Helzer’s opinion that Point Five Windows has “successfully sold” Frameless Velcro Screen System windows that were curved or oddly shaped is deserving of little weight. *See Huang, supra.*

With respect to the third enumerated advantage, while Mr. Helzer did state that in the \$720,000 contract some of the Frameless Velcro Screen System windows were sold “in large part” to avoid corrosion in the salt-water environment of the Bahamas, it has already been noted that the contract included doors, which are outside the scope of the appealed claims, and that the phrase “in large part” suggests that other factors also influenced the contract award. Moreover, there is no evidence that any other of Lundahl’s customers chose Frameless Velcro Screen System windows for this reason.

Finally, with respect to the fourth enumerated advantage (*i.e.*, the hook-and-loop-fastened screen being less visually intrusive), there is no evidence that any of Lundahl's customers selected the Frameless Velcro Screen System windows for this reason. At best, Lundahl has shown that the purchaser of the \$580,000 order chose Frameless Velcro Screen System windows (in part) because the screen is mounted between the fixed frame and the moving sash rather than on the exterior frame of an in-swing window, not because the Frameless Velcro Screen System screen is less visually intrusive than conventional screens. A72(¶¶ 21-23); A79 (¶¶ 7-8). Moreover, as the Board noted, A18, mounting the screen between the fixed frame and the moving sash was a feature already available in the prior art Kehne window. *See J.T. Eaton & Co, Inc. v. Atlantic Paste and Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) ("asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art").⁵

⁵ It is also worth noting that Lundahl's evidence of commercial success consists of raw sales figures without any evidence as to what share of the relevant market Lundahl's sales comprises. This Court has held that in the absence of reliable market-share evidence, sales figures provide "a very weak showing of commercial success, if any." *Huang*, 100 F.3d at 140.

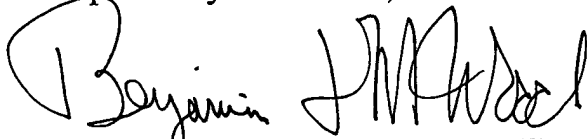
4. Even Evidence of Substantial Commercial Success Would Be Insufficient to Overcome the Prima Facie Case of Obviousness

Even evidence of substantial commercial success may be insufficient to overcome a strong case of *prima facie* obviousness. *See Leapfrog*, 485 F.3d at 1162 (patentee's substantial evidence of commercial success, praise, and long-felt need inadequate to overcome strength of *prima facie* obviousness showing). Here, the evidence of commercial success is far from substantial, while the *prima facie* obviousness case is substantial. Thus, the Board properly affirmed the examiner's rejection of the appealed claims as obvious.

VI. CONCLUSION

Since the Board correctly found that the appealed claims would have been obvious pursuant to 35 U.S.C. § 103, this Court should affirm that decision.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen Walsh", written over a horizontal line.

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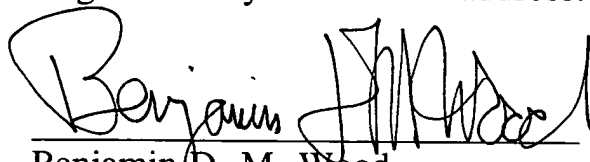
April 18, 2008

CERTIFICATE OF SERVICE

I hereby certify that on April 18, 2008, I caused two copies of the foregoing BRIEF FOR APPELLEE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE to be sent by overnight delivery to the following address:

William W. Cochran, Esq.
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I hereby certify that on April 21, 2008, I caused two copies of the foregoing BRIEF FOR APPELLEE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, with the addition of the phrase "and the Board's legal conclusions are reviewed *de novo*" inserted into the first sentence of the second full paragraph on page 10, to be sent by overnight delivery to the same address.


Benjamin D. M. Wood
Associate Solicitor

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